

SUPPORT FOR THE AMENDMENTS TO THE CLAIMS

The amendment to claim 1 seeks to incorporate the subject matter of original claim 4 into claim 1 and recites a preferred embodiment of the instant invention. Support for this amendment may be found in the instant specification, for example, at page 4, line 1.

The amendments setting forth instant claims 1 and 8 in outline form merely serve to more clearly recite the resin component of the instant invention, which may be chosen from either of two alternatives. This amendment does not change the meaning or the scope of the claims as originally filed; it merely clarifies Applicants' original intent as of the date of the filing of the instant application. Support for this amendment may be found in the instant specification, for example, at original claims 1 and 8 and at page 3, lines 1 through 24.

The amendments deleting one instance of the phrase "plus B)", at line 8 of claim 1 and at line 10 of claim 8, seek solely to insure consistency in antecedent basis by clarifying that in the instant adducts, the epoxy resin portion is epoxy resin A). This amendment adopts a suggestion of the Examiner at page 2, paragraph 1 of the November 4, 2004 Office Action in the "Claim Objections."

The amendment to claim 60 seeks solely to insure consistency in antecedent basis and proper claim dependency.

Upon the entry of the instant amendment, claims 1-3, 5-6, 8-16 and 58-62 will stand pending in the instant application. No new matter has been added by the instant amendment.

Claim Objections

Claims 1-6, 8-16 and 58-62 stand objected to because of informalities relating to the phrase A) plus B). The Applicants have adopted the Examiner's suggestion and have deleted the phrase "plus B)", as needed to insure that the claims read clearly in idiomatic English. Applicants respectfully request the reconsideration and the withdrawal of all claim objections.

Claim Rejections Under 35 USC 103

Claims 1-3, 6 and 58 stand rejected under 35 USC section 103(a) as being unpatentable over Correll et al. in view of Durand, both of record. The applicants respectfully traverse this rejection

Correll et al. fails to recite zinc powder. Further, Correll et al. corresponds to instant Example 4, at page 15 of the instant specification, a toughened epoxy coating which fails chip resistance testing at a 21 mil thickness. See page 20, lines 12-15 of the instant specification.

Correll et al. also teaches away from use of any fillers in the amount of more than 100 phr. See column 10, lines 37-52, especially 37-40 and 50-52. The coatings provided using fillers in any amount more than 100 phr exhibit undesirable stiffness and loss of flexibility.

Durand fails to recite either of the instantly recited polyhydroxyl functional crosslinker or elastomer-epoxy adduct. Further, Durand does not remedy the deficiencies of Correll et al. regarding zinc powder. At best, Durand teaches use of two specified and distinct zinc fillers (see Abstract and column 1, lines 38-40) and specifically teaches away from the use of a zinc powder, as instantly recited. See column 1, lines 40-42.

The elimination of an ingredient in Durand with retention of its function as a filler in coatings providing corrosion resistance and good film properties is evidence of non-obviousness. See Durand at column 1, lines 29-38.

Nevertheless, without acquiescing to the position taken by the Examiner, Applicants have amended the instant claims to recite a proportion of 150 or more phr of zinc powder which is clearly patentable over and not suggested by the art. Accordingly, Applicants hereby request the reconsideration and the withdrawal of all art rejections.

Regarding claims 3 and 6, the rejection is not understood because the rejected claims recite only elastomer adducts which are not disclosed, taught or suggested in the art.

Obviousness-Type Double Patenting

Claims 1, 4, 5-6, 58 and 60 stand rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over claims 1, 3 and 6 of U.S. Patent no. 6,677,032, to Grubb et al. Applicants respectfully traverse this rejection.

The rejection is improper. The core shell resin recited in claims 1, 3 and 6 of Grubb et al. was restricted from and cannot be cited against the elastomer "adduct" claimed in the instant application. 35 U.S.C. § 121. See the restriction requirement of U.S. Application Serial No. 09/173,146, mailed on March 03, 2000, at paragraph 6, wherein the Patent Office required a species election between the core-shell polymer, the polyhydroxyl functional crosslinker and the elastomer "adduct". Further, each of U.S. Application Serial No. 09/703,408, which became U.S. Patent no. 6,677,032, and the instant application were filed as a result of such restriction requirement; and both applications were required to cover the different species examined.

The Applicants respectfully request the reconsideration and the withdrawal of the rejections.

Claims 8, 10-16, 59 and 61-62 stand rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over claims 7, 9-14 and 16-20 of U.S. Patent no. 6,677,032, to Grubb et al. Applicants respectfully traverse this rejection.

With respect to claims 7, 9-14 and 16-17, the rejection is improper. The core shell resin recited in claims 7, 9-14 and 16-17 of Grubb et al. was restricted from and cannot be cited against the elastomer "adduct" claimed in the instant application. 35 U.S.C. § 121. See the restriction requirement of U.S. Application Serial No. 09/173,146, mailed on March 03, 2000, at paragraph 6, wherein the Patent Office required a species election between the core-shell polymer, the polyhydroxyl functional crosslinker and the elastomer "adduct". Further, each of U.S. Application Serial No. 09/703,408, which became U.S. Patent no. 6,677,032,

and the instant application were filed as a result of such restriction requirement; and both applications were required to cover the different species examined.

The Applicants respectfully request the reconsideration and the withdrawal of these rejections.

With respect to claims 18-20 of U.S. Patent no. 6,677,032, the elimination of the second coating layer with retention of the chip resistant coating properties is evidence of unobviousness. Nevertheless, without acceding to the correctness of the Examiner's position, the Applicants have submitted a terminal disclaimer to obviate the obviousness-type double patenting rejection in view of U.S. Patent no. 6,677,032. Accordingly, Applicants respectfully request the withdrawal of all obviousness-type double patenting rejection in view of U.S. Patent no. 6,677,032.

Claims 58-62 stand rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over claims 1, 6, 9, 13 and 16 of U.S. Patent no. 6,346,292, to Grubb et al. Applicants respectfully traverse this rejection.

The rejection is improper. The core shell resin recited in claims 1, 6, 9, 13 and 16 of U.S. Patent no. 6,346,292 was restricted from and cannot be cited against the elastomer "adduct" claimed in the instant application. 35 U.S.C. § 121. See the restriction requirement of U.S. Application Serial No. 09/173,146, mailed on March 03, 2000, at paragraph 6, wherein the Patent Office required a species election between the core-shell polymer, the polyhydroxyl functional crosslinker and the elastomer "adduct". Further, each of U.S. Application Serial No. 09/703,290, which became U.S. Patent no. 6,346,292, and the instant application were filed as a result of such restriction requirement; and both applications were required to cover the different species examined.

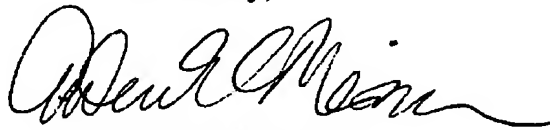
The Applicants respectfully request the reconsideration and the withdrawal of all obviousness-type double patenting rejections.

CONCLUSION

It is submitted that the instant claims are in condition for allowance. An early and favorable action on the merits is earnestly solicited. If the Examiner has any questions, he or she is urged to contact the undersigned at the number given below.

Applicants file herewith a terminal disclaimer and the requisite fee. Please charge any additional fees to deposit account no. 18-1850.

Sincerely,

A handwritten signature in black ink, appearing to read 'Andrew E.C. Merriam', with a long, sweeping horizontal flourish extending to the right.

Andrew E.C. Merriam
Reg. No. 47,268

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